

REMARKS

Claims 1-5, 7-10, and 20-31 are pending in this application. Claims 1 and 28 have been amended to cover additional embodiments disclosed in the application. Claim 21 has been amended to make it independent. New claims 30 and 31 have been added. Based on the amendments and following remarks, applicant respectfully requests reconsideration of the remaining claims and submits that the application is in condition for allowance. Support for the amendments to the claims can be found throughout the application as filed, including without limitation paragraph 16. Accordingly, applicant respectfully requests that this Amendment be entered in its entirety. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented above with an appropriate defined status identifier.

I. Claim Objections

Claim 21 was objected to in the Office Action as containing allowable subject matter, but being dependent upon a rejected base claim. The Examiner stated that claim 21 “would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” Applicant would like to thank the Examiner for acknowledging that claim 21 contains allowable subject matter. In response to the Examiner’s suggestion, applicant has amended claim 21 into independent form as suggested by the Examiner. Therefore, applicant respectfully requests the Examiner withdraw the objection and allow claim 21.

II. Claim Rejections

A. 35 U.S.C. § 112

In the Office Action, claim 29 was rejected under 35 U.S.C. § 112, second paragraph as being indefinite because “[i]t is unclear if claim 29 is an article or method claim.” Claim 29 is a method claim that recites a process for manufacturing the construction panel of claim 1. Applicant reserves the right to properly rejoin restricted claims upon allowance of a base claim. MPEP §809.

B. 35 U.S.C. § 103

In the Office Action, claims 1-5, 7-10, 20 and 22-29 were “rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnston (U.S. Patent 2096968) in view of Wang (U.S. Patent 5922379).” The Office Action stated that:

Johnston discloses a construction panel in figure V having upper and lower portions... The material of construction has been deemed a matter of choice. One of ordinary skill in the art would have appreciated all of the materials available for use and would have selected any one which fulfilled the intended purposes of his panel. Nevertheless, Wang teaches a thermoplastic material having a combination of a natural plant fiber and synthetic polymer...

Applicant respectfully disagrees that Johnston in view of Wang states a *prima facie* case of obviousness. A *prima facie* case of obviousness requires three basic criteria:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.

MPEP § 2142.

Johnston when combined with Wang does not meet any of these criteria, much less all of them. Even a combination of the references fails to teach all of the elements of the rejected claims. The Office Action also points to no suggestion or motivation in the references or within the art to modify Johnston with a composition of Wang to achieve the claimed invention. Furthermore, the Office Action fails to teach or suggest that modifying Johnston with the composition of Wang to achieve the claimed invention will have any expectation of success.

First, the prior art references, alone or in combination, fail to teach or suggest the composition of the present claims. Specifically, the claims recite a composition comprising a synthetic polymer. Neither Johnston nor Wang teach a composition with a synthetic polymer. The Office Action cites claims 26 and 36 as supporting a synthetic polymer, stating “the polymeric material is polypropylene and polyethylene and combinations thereof. See claim 36.” However, claim 36 recites a “plasticizer is selected from glycerol, ethylene glycol, 1,3-propanediol, propylene glycol, sorbitol, sorbitan, mannitol, diglycerol, butanediol, urea, glycerol monoacetate, glycerol

diacetate, and a mixture thereof.” One skilled in the art recognizes that all of the chemicals recited in claim 36 are plasticizers and not synthetic polymers, much less polypropylene or polyethylene as stated in the office action. Nowhere do the cited references teach suitable compositions that contain synthetic polymers. Moreover, claims 1-5, 7-10, 20-27 and 29-31 specify that the material contains “about 40 to 75 percent natural fiber.” In contrast, Johnston does not disclose the use of natural fiber and Wang only teaches compositions that contain “5 to 25 wt. % natural cellulosic fiber,” (column 2, line 59) which is well below the amount specified in claims 1-5, 7-10, 20-27 and 29-31. Accordingly, the combination of Johnston and Wang cannot render the present claims *prima facie* obvious because the references, alone or in combination, fail to teach or suggest all of the claim elements.

Additionally, neither the Office Action nor the references themselves provide a suggestion or motivation or to combine the teachings of the cited references other than the statement in the Office Action that “*all* of the materials [are] available for use[.]” Moreover, Johnston and Wang deal with disparate, non-related articles. Johnston relates to roofing shingles. Wang deals with *biodegradable* “foam packaging material.” Col. 1, line 10. Neither of these references, nor the knowledge in the art, provides a teaching or suggestion that the materials for biodegradable foam packaging materials are suitable for a roofing shingle. Given the disparate uses for these articles, it is also highly unlikely that one skilled in the art would have any expectation of successfully making the shingle of Johnston with the biodegradable packaging material of Wang. Biodegradable materials by their very nature break down upon exposure to the elements and cannot meet the requirements needed to make a useful shingle. As such, there would be virtually no chance of success in combining the references as proposed in the Office Action. Additionally, a biodegradable packaging material of Wang would not meet any of the rigorous testing standards set forth in claims 23 or 24. Accordingly, the references cited in the Office Action cannot state a proper *prima facie* case of obviousness and applicant respectfully requests the Examiner withdraw the rejection.

The statement in the Office Action that “the material of construction has been deemed a matter of choice” also fails to treat the claimed invention as whole. As stated in the MPEP, a “statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’... is not

sufficient to establish a *prima facie* case of obviousness [.]” MPEP §2143.01 (emphasis added). In fact, there is no motivation to combine the references as suggested in the Office Action.

Applicant also submits that the patentability of the claimed invention is being judged under the improper obvious to try standard, where

what would have been ‘obvious to try’ would have been to vary all parameters or try each of numerous possible choices [here, the materials for the construction panel] until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful....

MPEP§ 2145 X.B. In stating that “the material of construction has been deemed a matter of choice” the Office Action is merely inviting the skilled artisan to try each and every possible combination of known materials until they achieve the successful result of the claimed invention.

For the foregoing reasons, applicant respectfully submits that the cited references do not state a *prima facie* case of obviousness of the claimed invention and respectfully request the Examiner withdraw these rejections.

CONCLUSION

In view of the above remarks, it is respectfully submitted that this application is in condition for allowance. Early notice to that effect is earnestly solicited. The Examiner is invited to telephone the undersigned at the number listed below if the Examiner believes such would be helpful in advancing the application to issue.

Respectfully submitted,

Date April 16, 2004

By 

FOLEY & LARDNER LLP
Customer Number: 23524
Telephone: (608) 258-4991
Facsimile: (608) 258-4258

Robert N. Young
Attorney for Applicant
Registration No. 48,412